

RECEIVED  
CENTRAL FAX CENTER

JUL 17 2007

Remarks/Arguments**I. Request for Reconsideration**

Applicant would like to thank Mr. Grant for allowing a telephonic discussion on July 16, 2007 regarding the May 8th rejection of claims 17-23. The subject matter of the discussion turned on the degree to which the examiner considered the claim limitation "apically-rounded" claws. In the discussion, Mr. Grant offered to withdraw the Office Action rejections of April 6, 2007 and May 8, 2007; and issue a new Action on the merits more fully responsive to Applicant's response of January 19, 2007.

Based on the results of said telephonic discussion, Applicant respectfully requests reconsideration of the claim amendments and arguments presented in his Response of January 19, 2007. However, due to the helpful suggestion of Mr. Grant, the Applicant has more clearly defined the apically-rounded nature of the hammerhead as being "transversely apically-rounded." The amendments are presented (i.e. labeled) as responsive to the Office Action of October 19, 2006.

**II. Rejections Under 35 U.S.C. § 103**

Claims 1-16 were rejected under 35 U.S.C. §103 as obvious in view of Te in combination with Hu. In making this rejection, it was asserted that Te discloses "a hammerhead [with]...a nail holder having numerous slots having magnets[, but not] a small claw and a large claw." It was further asserted that "Hu discloses a hammer wherein the claw comprises a small claw and a large claw...to enhance the versatility of the tool when used in tightly constrained spaces", and that such would be the motivation to combine the claws of He with the hammerhead of Te.

Applicant asserts that a prima facie case of obvious cannot be maintained against claim 17. In order to establish a prima facie case of obviousness, three criteria must be met: (1) the prior art references must teach or suggest all the claim limitations; (2) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available in the art, to modify reference or to combine reference teachings; and (3) there must be reasonable expectation of success. Not all of the

limitations of claim 17 are present in Te and Hu, and no motivation exists in the record to alter either Te or Hu to include all of the limitations of claim 17.

1. All the Limitations of Claim 17 Are Not Present in Te and Hu

Applicant's newly added claim 17 includes limitations that cannot be found in either Te or Hu. In particular, Applicant would like to highlight the absence of transversely apically-rounded, flared claws and the absence of motivation cited in the record to alter Te to include such features.

*A. Neither Te Nor Hu Discloses Flared Claws*

Applicant includes in his new claim 17 the flared claws originally presented in his claim 12. As shown in Applicant's Fig. 1, the flared claws diverge in the direction of the distal end of the hammerhead. A primary advantage of flared claws is that such dimensions allow for the placement of non-linear nail removal voids (see Fig. 1, elements 5a and 5b). Note that the groove 5a, rather than facing in the same direction as groove 5b, exposes its void in the direction of the claw that defines it (i.e. leftward as viewed in Fig. 1). Similarly, groove 5b veers commensurate with its claw's orientation (i.e. rightward as viewed in Fig. 1).

Claws that are linear and include nail removal voids, such as those of Hu, include an inherent disadvantage: one claw may obstruct the other in removing a nail from a surface. Nails are not located in open surfaces; frequently a nail may be lodged within a confined space. When an obstructed nail requires removal, it is advantageous to have a removal device sporting as little bulk as possible. Flared claws minimize the bulk necessary to remove a nail because only a single claw will ever be oriented towards a nail requiring removal. Linear claws, however, will always have two claws oriented in the same direction.

As neither Te nor Hu disclose flared claws with non-linear nail-removal voids, Applicant requests that the examiner withdraw his obviousness rejection for at least this reason.

**B. Neither Te Nor Hu Discloses Apically-Rounded Claws**

Applicant includes in his claim 17 a hammerhead that includes transversely apically-rounded claws as was originally presented in his claim 1. As best shown in Applicant's Figs. 4A and 4B, the rounding of the apex of the hammerhead gives the hammerhead an upper surface that allows it to roll on a surface in a direction perpendicular to the longitudinal direction of the hammerhead. Neither Te nor Hu include transversely apically-rounded claws.

Apically-rounded claws bestow a significant advantage over the hammerheads disclosed in Te and Hu. The curved shape of the hammerhead in Applicant's claim 17 minimizes damage to a surface when a nail is being removed. The Te and Hu devices, however, only disclose hammerheads with sharply-edged surfaces. To turn either the Te or Hu hammer on its side, which often occurs in nail-removal, would foist that sharp edge into the surface from which the nail is being removed and potentially damage that surface. Applicant's apically-rounded hammerhead allows the hammer of claim 17 more universal applicability than the hammers of Te and Hu; a rounded apex minimizes damage to more delicate surfaces for which a hammer might be used, e.g. furniture.

As neither Te nor Hu disclose an apically-rounded hammerhead, Applicant requests that the examiner withdraw his obviousness rejection for at least this reason.

**C. Conclusion**

Neither Te nor Hu include a hammerhead that has apically-rounded claws in conjunction with non-linear claws as Applicant claims in his claim 17. As claim 17 recites two limitations that are not present the cited references, Applicant requests that the Examiner withdraw his obviousness rejection.

**2. There Is No Cited Suggestion or Motivation to Modify the References of Hu or Te to Include Either Flared Claws or Apically-Rounded Claws.**

Although the examiner cites motivation to alter the hammer of Te to include the small claw/large claw features of Hu, there is no suggestion present to further alter Te to include either flared claws or transversely apically-rounded claws. It is settled law that

an examiner can satisfy the burden of obviousness in light of combination “only by showing some objective teaching [leading to the combination].” *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir.1992). That teaching or suggestion is “essential” to avoid hindsight. *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir.1988). As a suggestion to modify Hu to include flared claws and/or apically-rounded claws is not present in the record, Applicant requests that the examiner withdraw the rejection of Applicant’s claim 17.

### III. Newly Presented Independent Claims 20 and 23

Applicant has further added features from the cancelled claim 1 as independent claims 20 and 23 to more accurately define the scope of the present invention. With respect to claim 23, and all claims depending therefrom, Applicant would point to the limitations argued in section II, *infra*, which would similarly serve to distinguish claim 23 from uncovered prior art. For reasons stated in section II, Applicant requests allowance of claim 23.

Claim 20 merits allowance as no uncovered references includes a stationary hammerhead in combination with side-mounted multiple, peripheral, and varying-sized nail-retention grooves. There is a trend in the prior art to use either a rotating member (such as the one disclosed by Te), or a top-mounted nail-retention groove on a hammerhead. As none of the uncovered references include multiple side-mounted nail-retention slots on the hammerhead, such a claim merits allowance.

Respectfully Submitted,

Date: 7/17/2007



M. Keith Blankenship, Esq.  
Blankenship Law, PLLC  
2815 Hartland Rd. Suite 120  
Falls Church, VA 22043  
Phone: 703-205-0044  
Fax: 703-205-1238  
[www.blankenshiplawllc.com](http://www.blankenshiplawllc.com)